

II. REMARKS

Claims 1-20 are pending in this application. By this Response, Applicants provisionally elect Group III, claims 12-20, with traverse. Prompt examination on the merits is respectfully requested.

With regard to the Restriction Requirement, MPEP § 803 states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§ 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) -§ 806.04(i), § 808.01(a), and § 808.02).

On the first element, in the Restriction Requirement, the Office asserts that Group I and Group II, the latter of which includes only a dependent claim, are related as combination and subcombination. Applicants respectfully traverse this basis for restriction for the following reasons.

First, Applicants submits that restriction of a dependent claim is a highly unusual and improper practice. 35 U.S.C. §112, paragraphs 4 states: "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed." The dependent claim is called a dependent claim because it is reliant on the independent claim, and specifies a further limitation. Applicants submit that it is illogical to characterize a dependent claim as an independent invention. A very large number of dependent claims in most patent applications can be classified in different sub-classes of the same class. Indeed, that is one of the reasons sub-classes exist - so the Patent Office and the public can find the "further limitations." Based on the Office's logic for restriction, practically any dependent claim can be withdrawn from consideration simply by alleging a separate sub-class must be

searched. Restriction on these grounds, however, defeats the purpose of dependent claims. Applicants appreciate the burdens on the Office and the need to limit over-reaching in terms of the number of inventions in each application. However, the common and proper custom is to exercise restriction practice only relative to independent claims.

Second, MPEP §806.05 states that “[i]f [the related inventions] are not distinct, restriction is never proper.” Applicants submit that dependent claims are never distinct, and therefore, the Office cannot demonstrate that the inventions are distinct. As the Office states, distinctness requires, among other things, that the “subcombination can be shown to have utility either by itself or in other and different relations.” MPEP §806.05(c). The Office asserts that the “subcombination has separate utility such as a silicide resistor in a device that does not require a via contact to a layer below.” Applicants respectfully submit this conclusion is faulty for a number of reasons. To begin, the Office’s conclusion is illogical when one considers that the subcombination here is a dependent claim. It is ludicrous to assert that the dependent claim can have separate utility from the independent claim when the dependent claim requires everything in the independent claim. How does one use claim 4 by itself or in other and different relations without using claim 1? One cannot because claim 4 requires the limitations of claim 1. Furthermore, the Office’s conclusion is faulty because the Office’s illustrative separate utility for the subcombination actually excludes the subject matter of the subcombination, i.e., a via or wire. That is, the Office is arguing that method requiring the step of forming, for example, a via (claim 4) has “separate utility such as a silicide resistor in a device that does not require a via.” That conclusion does not make sense.

Turning to the second element of MPEP § 803, Applicants submit that the Office has also failed to prove that a serious burden exists relative to the separation of Group I from Group II,

and also relative to the separation of Groups I and II from Group III. The Office asserts a serious burden exists because searching in numerous sub-classes would be necessary, and supports this argument in the Restriction Requirement by selecting a different sub-class for each Group to show separate status in the art.

Applicants submit that the Office's conclusion that a serious burden exists relative to separating Group I from Group II is greatly weakened by two facts. First, the Office is relying on sub-classes of the same class to show separate status in the art. This showing would be acceptable if the claims were independent claims because it would evidence truly independent and distinct inventions. But, where the claims are dependent, Applicants is entitled to searching of the necessary sub-classes so that they can determine whether those further limitations are patentable compared to the independent claims. Second, the Office has failed to show serious burden because class 438/382 selected for Group I includes merely 237 patents and class 438/637 selected for Group II includes only 1729 patents total (according to the USPTO website search engine), which presumably would be searched in most part electronically. Certainly, examination of this application would be faster without having to search the larger sub-class, but 1729 patents searched electronically does not amount to a serious burden, especially when the Office is looking for additions to a larger method. "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

With regard to the Restriction Requirement of Groups I and II from Group III, Applicants also submit that no serious burden exists. Again, the Office asserts a serious burden exists because classes 438/382 and 438/637 would have to be searched for the method. However, those classes amount to a total of 1966 patents, which does not amount to a serious burden when

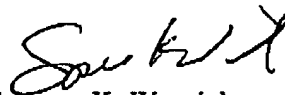
searched electronically. Again, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

In view of the foregoing, Applicants respectfully request withdrawal of the Restriction Requirement between Groups I, II and III. Should the Examiner require anything further from Applicants, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

Dated:

6/29/05


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